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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,171	04/19/2004	Daniel M. Green	UN11.0090CON	2412

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EXAMINER

LEE, Y YOUNG

ART UNIT PAPER NUMBER

2613

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,171

Applicant(s)

GREEN ET AL.

Examiner

Y. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/3/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a method for acquiring images using an automated optical microscope system, classified in class 348, subclass 79.
 - II. Claims 16 and 17, drawn to an automated fluorescence imaging system, classified in class 378, subclass 44.
 - III. Claims 18-24, drawn to an automated imaging system, classified in class 348, subclass 61.
 - IV. Claims 25-30, drawn to an automated method for acquiring images, classified in class 348, subclass 61.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as an automated optical microscope system. See MPEP § 806.05(d).
3. Inventions I, IV and II, III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

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806.05(e)). In this case the method as claimed in Group I can be practiced by another materially different apparatus such as an automated fluorescence imaging system.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III, or IV, and vice versa, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. G. Elman on 5/23/05, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

8. The drawings are objected to because all diagrammatic blocks and features in Figures 1-4, 6-8, and 11 are required to be distinctly labeled to indicate contents or

function with legends (37 C.F.R. 1.83(a), 1.84(o)) since they are necessary for understanding of the drawing. Correction is required.

Claim Objections

9. Claim 1 is objected to because of the following informalities: line 9, "the" should be changed to --a--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman et al (5,233,197).

Bowman et al, in Figures 1-4, 10, and 11, discloses a high speed digital imaging microscope using the same method for acquiring images as specified in claims 1-15 of the present invention, comprising the steps of configuring an optical microscope system which comprises a camera CCD, a microscope 10, an information handling system 11 and a device 65 for altering an image acquisition parameter; acquiring images at a rate substantially close to the maximum image acquisition rate of the camera (e.g. 1 image every 5 sec); and altering, during image acquisition, at least one image acquisition parameter 65 which applies to the next image; wherein the configuring step comprises initializing a range of values (Fig. 10) over which the image acquisition parameters will vary during the acquiring of images.

With respect to claims 2-15, Bowman et al discloses at least one image acquisition parameter being altered during image acquisition is focus plane, light intensity, excitation wavelength (e.g. Fig. 10) or emission wavelength, whereby a stack of fluorescence images is acquired; initializing a duration of time during which images will be acquired 504; wherein, during acquisition of at least one image, excitation wavelength and emission wavelength which apply to the next image are altered (Fig. 10); wherein the information handling system 11 comprises a memory, further comprising the step of storing a stack of images in the memory; an objective lens and an objective lens positioner, and wherein the computer program product 11 contains programming for directing the objective lens positioner to reposition the objective lens 42 between images; an examination site and an examination site positioner, and wherein the computer program product 11 contains programming for directing the examination site positioner 101 to reposition the examination site between images.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (571) 272-7334. The examiner can normally be reached on (571) 272-7334.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Y. Lee
Primary Examiner
Art Unit 2613

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